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Name Examiner Nguyen, Son T. Art Unit 3643	571-273-8300	571-272-7436
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From: Antonio R. Durando	520-243-3383	520-577-6988
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Message: Examiner's Courtesy Copy of Petition to the Director

Applicants: Ford, Garrett


Attorney Docket No.: 122142.00009

Ser. No. 10/755,984

Filed: 01/13/2004

Title: Horse Boot with Dual Tongue Entry System

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: FORD, GARRETT N. DOCKET NO.: 122142.00009
SERIAL NO.: 10/755,984 FILED: 01/13/2004
EXAMINER: NGUYEN, SON T. ART UNIT: 3643
TITLE: HORSE BOOT WITH DUAL TONGUE ENTRY SYSTEM

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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CERTIFICATE OF TRANSMISSION

I hereby certify that on this 2nd day of May, 2006, this correspondence is being deposited with the U.S. Postal Service with sufficient postage as first-class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, with copy transmitted via facsimile (571-273-8300) to the United States Patent and Trademark Office, Attn: Examiner Son T. Nguyen, Art Unit 3643.

By: 

Antonio R. Durando

PETITION TO THE DIRECTOR

UNDER 37 C.F.R. 1.181

FOR REVIEW OF PREMATURENESS OF FINAL REJECTION

Dear Sir:

This is a Petition under 37 C.F.R. 1.181 and MPEP Sect. 1002.02(c) seeking review of the finality of a rejection in the above-captioned case. According to the language of these sections, no

fee is believed to be due with this Petition. If a petition fee is nonetheless due, please charge it to Deposit Account No. 04-1935.

A Notice of Appeal with the required fee and a Request for a One-Month Extension of Time in the case are being submitted contemporaneously under separate cover.

The issue of prematurity of the final rejection has been raised with the Examiner pursuant to MPEP Sect. 706.07(c) in a Request for Reconsideration filed on March 10, 2006. The Examiner maintained the finality of the rejection by Advisory Action dated March 20, 2006.

HISTORY OF RELEVANT FACTS TO THE CASE

The case was filed on January 13, 2004, with 19 claims, of which Claims 1 and 18 are independent claims. Both independent Claims 1 and 18 were rejected as anticipated by Dallmer (US 4,744,422) in a first non-final action dated February 24, 2005.

In reply to the first action, the applicant amended both Claims 1 and 18, and added two new dependent claims. In particular, Claim 18 was amended as follows (only this claim is relevant to the review sought by the applicant):

"18. (currently amended) An article of footwear for ~~an~~ a hoofed animal comprising:

a support ~~for bearing~~ designed to bear against a leg hoof of the animal and against the ground; and

an enclosure ~~for enclosing~~ designed to enclose at least part of the leg hoof of the animal, said enclosure including a wall means on said support, a tongue on said support movable relative to said wall means, and at least one band of elastic material connected to said tongue and to said wall means."

After receipt of the amended claims, the Examiner performed a second search and finally rejected all claims on new grounds, as anticipated by Glass (US 4,174,754), in a Final Action dated June 10, 2005. The applicant appealed the rejection and filed his Appeal Brief on October 26, 2005.

Upon review of the case on appeal, the Examiner withdrew the case from appeal, performed a third search, and again finally rejected all claims (including Claim 18) on new grounds, as anticipated by Adam (US 840,892), by Final Action dated January 10, 2006.

As mentioned above, the applicant requested reconsideration of the finality of the rejection, which was maintained. For the reasons stated below, the applicant respectfully requests the Director's review of the Examiner's decision.

ARGUMENT

MPEP Section 706.07(a) provides that, a "second or any subsequent action on the merits shall be made final, except where the Examiner introduces a new ground of rejection that is [not] necessitated by applicant's amendment" (Emphasis Added) The section goes on to state, "[A] second or any subsequent action on the merits in any application or patent involved in reexamination proceedings should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed. See MPEP § 904 et seq. For example, one would reasonably expect that a rejection under 35 U.S.C. 112 for the reason of incompleteness would be replied to by an amendment supplying the omitted element." (Emphasis Added)

Claim 18 of this application was amended after the first action solely to overcome a Section 112 rejection and to specify that the invention was directed to a "hoofed" animal, rather than just an animal. The language was amended to delete the word "means," to change the words "bearing" and "enclosing" to --designed to bear-- and --designed to enclose--, and to recite a -hoof-- instead of a "leg," consistent with the specification and drawings describing

the horse boot of the invention. The claim was not amended to distinguish the Dallmer reference, as evidenced by the fact that the Remarks in reply to the first office action do not in any way refer to the changed language ("hoof") as a distinguishing feature. In fact, the Dallmer reference already describes a boot for the hoof of a horse and, therefore, it could not have been distinguished by limiting the claim to a hoofed animal.

In view of the foregoing, it is respectfully submitted that the amendment to Claim 18 did not necessitate a new search and the finality of the second action was premature under the first-prong exception of the guidelines provided by MPEP Section 706.07(a).

Furthermore, in view of the fact the applicant's invention deals only with a horse boot, changes that would more clearly define the environment within which the horse boot is used should reasonably have been expected to be made as well. Thus, the second-prong exception of the guidelines provided by MPEP Section 706.07(a) is also believed to apply.

Section 706.07(a) refers to MPEP Section 904 et seq. for further guidance. This section states:

"The first search should be such that the examiner need not ordinarily make a second search of the prior art, unless necessitated by amendments to the claims by the applicant in the first reply, except to check to determine whether any reference which would appear to be substantially more pertinent than the prior art cited in the first Office action has become available subsequent to the initial prior art search. The first search should cover the invention as described and claimed, including the inventive concepts toward which the claims appear to be directed. It should not be extended merely to add immaterial variants."
(Emphasis Added)

It is respectfully submitted that original Claim 18, in view of the specification of the invention (which is solely descriptive of a horse boot), clearly was directed toward a hooved animal. Therefore, Claim 18 falls squarely within the search requirements of MPEP Section 904. Thus, the Glass and Adam patents produced by the second and third search (which also describe horse boots) should have been referenced after the first search; or, if referenced later, they should not be used as the basis for a final rejection unless their citation was necessitated by an amendment that rendered it necessary, which is not the case here because the

only added limitation (a horse boot for a "hoofed" animal) was already disclosed by the first reference (Dallmer).

Section 904.02 further states:

"The search should cover the claimed subject matter and should also cover the disclosed features which might reasonably be expected to be claimed. The field of search should be prioritized, starting with the area(s) where the invention would most likely be found in the prior art." (Emphasis Added)

In view of the fact that the present application describes and deals only with a boot for a horse, and the further fact that the only substantive amendment made to Claim 18 changed the word "leg" to "hoof," it is respectfully submitted that the original search should have covered a boot for the hoof of horse (and indeed it did). A new search should not have been required - and in fact it was not, as evidenced by the fact that the second reference (Glass) was necessarily found to be cumulative when the Examiner withdrew the case from appeal. The same applies to the third search, which produced another horse reference (Adam), which, if not cumulative, should clearly have been applied (or at least referenced) in the first action. (Neither Glass nor Adams was referenced in the first

action; otherwise, the applicant agrees that the finality of the subsequent two actions would have been proper.)

The applicant in this case amended Claim 18 once. To the extent that a substantive amendment was made, it was not presented to distinguish the art (Dallmer) cited against it. The amendment reflected an inventive concept toward which the original claim clearly appeared to be directed (see MPEP Section 904) and it recited a disclosed feature that might reasonably be expected to be claimed (see MPEP Section 904.02). Therefore, it is respectfully submitted that the present case falls squarely within the factual situation for which the MPEP proscribes the issuance of a final action.

Contrary to the requirements of PTO procedure, the Examiner performed a second search for new art (Glass), which the applicant had to overcome by filing an appeal. The Examiner then performed a third search for yet another reference (Adam) which is clearly within the scope of the "inventive concepts toward which the claims appear[ed] to be directed," namely a horse boot. Nevertheless, the Examiner again finally rejected Claim 18, once more leaving the applicant no alternative but to follow, for the second time, the time-consuming and expensive process of filing an appeal.

The applicant is unable to find anything in the Regulations or MPEP supporting such a piecemeal approach to patent prosecution, even under the more stringent practice rules recently adopted by the PTO. If permitted, such an approach to searches and rejections would render the search requirements of Section 904 and the finality exceptions of Section 706.07(a) meaningless. After an applicant has amended a claim once (regardless of whether still within the same inventive concept or directed to a feature which might reasonably be expected to be claimed), an Examiner could apply cumulative art not referenced in the first action, force the applicant to appeal (or file an RCE), withdraw the appeal and issue another final action on more cumulative art, forcing again the applicant into an appeal with the attendant cost of a supplemental brief, and so on.

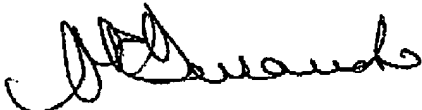
It is respectfully submitted that this type of arbitrary and piecemeal examination does not in any way contribute to improved quality of prosecution. Rather, it creates immense frustration among seasoned practitioners; it confuses less experienced practitioners who should be exposed to a high level of adherence to the PTO's own procedures; and it discourages individual inventors from embarking on a seemingly arbitrary, and therefore more costly,

process of patent review. To use an old expression, "this is no way to run a railroad."

In view of the various requirements of the MPEP cited above, it is respectfully submitted that the finality of the latest office action in this case was premature. Accordingly, the applicant requests that the finality of the action be reconsidered and that the newly submitted amendment be entered for consideration in the contemporaneously pending new appeal.

Please charge any cost associated with this response to our Deposit Account No. 04-1935.

Respectfully submitted,



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